

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
Wm. A. KNAUS et al.) Group Art Unit: 3626
Application No: 09/816,152) Examiner: Lena Najarian
Filed: March 26, 2001)
Title: **BROADBAND COMPUTER-BASED NETWORKED SYSTEMS FOR
CONTROL AND MANAGEMENT OF MEDICAL RECORDS**

MAIL STOP = APPEAL BRIEF - PATENTS

Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO EXAMINER'S ANSWER

Honorable Sir:

The Examiner's January 25, 2007 Answer (the "Answer") fails both to analyze and rebut the legal arguments and factual recitations in Appellant's October 12, 2006 Brief on Appeal (the "Brief"), as we show below. The Examiner's inability to support the reasoning behind the rejections is eloquent demonstration that the rejections are improper, that Appellant's application satisfies established legal standards, and that Appellant is entitled to an immediate withdrawal of the rejections.

The Answer seeks to justify the rejections in six categories, labeled A through F. Answer at 21. Appellant will address these categories in order of importance, rather than chronologically, to pinpoint the obvious, fatal deficiencies in the rejections themselves, which remain uncorrected and unsupported in the Answer.

**The Examiner's Inconsistent Interpretations of
"Certification," "Non-Repudiation," and "Accuracy"
Demonstrate That the Rejections Must Be Withdrawn**

Arguments D and E (Answer at 23-25) consider Appellant's affidavit ("Affidavit") swearing behind Segal. Answer at 5-13. Appellant's Affidavit is sufficient to swear behind Segal unless the Examiner's interpretations of "certification," "non-repudiation," and "accuracy" withstand analysis. (See Appellant's Brief at 10-11, 14). However, the Examiner's attempt to justify her interpretations of these words only underscores the facial inconsistency, and thus the legal insufficiency, of her approach.

The Examiner concedes that at times – only when it suits the purposes of rejection – she interprets "accuracy" as equivalent in meaning to "certification" and "non-repudiation" in the Affidavit and the application. At other times – when this same equivalency of meaning would compel withdrawing the rejections – she changes her interpretation and declares that "accuracy" means neither "certification" nor "non-repudiation" in those documents.

The Examiner complains that Appellant cannot choose to be its own lexicographer unless it sets out a special definition explicitly, deliberately, and precisely. Brief at 23. This is beside the point. No matter whether the words of the claims are given a special meaning or their normal English meaning, Appellant shows that a consistent interpretation of "accuracy" inevitably leads, either way, to a withdrawal of the rejections. Appellant's Brief at 14. What the Answer fails to refute is Appellant's point that the Examiner cannot have it both ways and sustain rejection. Appellant shows that a consistent interpretation of "accuracy" requires, either way, withdrawal of the rejections based on Segal. Appellant's Brief at 14.

These consequences are straightforward. If "certification" and "non-repudiation" are given their normal English meanings, Segal is not relevant prior art, and all rejections based in any part on Segal are in error.

If, however, "accuracy" is interpreted to mean "certification" and "non-repudiation," then the Affidavit is sufficient to swear behind Segal, because it then covers "accuracy." (The Examiner's other ground for giving no effect to the Affidavit, that it lacks a proper "nexus," is also disposed of in Appellant's Brief, as we review again below.)

The Answer arbitrarily and capriciously shifts the meaning of words in the claims in order to support mutually inconsistent rejections, despite how the applicant uses those words in the claims and the specification. This defect in processing is both obvious and unsustainable.

The Examiner Fails to Justify Imposing a “Nexus” Requirement Under 37 CFR § 1.131 and a Whole Invention Requirement Under MPEP 715.02

Arguments “B” and “D” the Answer evince puzzlement; for the Examiner cannot find the whole of Appellant’s claimed invention, or something falling within the claims (in the sense of 37 CFR §1.131 that something falling within the claim reads on the invention), in the Affidavit; and the Examiner therefore sees no “nexus” between what is in the Affidavit and the claimed invention. For whatever reason, however, the Answer fails even to discuss – much less rebut – Appellant’s two legal arguments (Brief at 15-16) demonstrating that the “nexus” analysis is improper as a ground for rejection.

The first legal point is that a “nexus” requirement cannot be imposed under 37 CFR §1.131, but only under §1.132. The second legal point is that MPEP §715.02 requires Appellant only to show that its Affidavit establishes possession of either the whole invention or something falling within the claim in the sense that the claim as a whole reads on it. The Appellant specifically need not disclose its entire claimed invention in the Affidavit. It is more than sufficient that the Affidavit establishes possession of something falling within the claim in the sense that the claim as a whole reads on it.

Appellant has no need to repeat the extensive legal analysis of these issues in its Brief (at 7-10, 15-16). It is sufficient that the Examiner has no response whatever to these documented, specific, conclusive legal arguments. Consequently, the rejections based on a lack of “nexus,” and on Appellant’s failure to disclose its entire claimed invention in the Affidavit, must fall.

Consequently, if the meaning of “accuracy” is deemed to include “non-repudiation” and “certification,” then the Affidavit is sufficient to swear behind Segal. If “accuracy” is not deemed to include “non-repudiation” and “certification,” then Segal is not relevant prior art. In either event, the rejections based on Segal must be withdrawn.

Conclusion

All other arguments in Appellant's Brief stand untouched in the Answer.

Appellant respectfully requests that the rejections be withdrawn and that the claimed invention be declared allowable.

Applicant submits herewith the fee for a one month extension of time (\$60) via credit card. If any additional fees are deemed required in the filing of this reply, please charge any shortage in fees due in connection with the filing of this paper to Deposit Account 14-1437, referencing Attorney Docket No. 8123.002.

Respectfully submitted,
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